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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,200	02/01/2002	Masato Oshika	218797US0	7492

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EXAMINER

ELHILO, EISA B

ART UNIT PAPER NUMBER

1751

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/060,200

Applicant(s)

OSHIKA ET AL.

Examiner

Eisa B Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 5) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 6) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 7. 6) ☐ Other: \_\_\_\_\_

Art Unit: 1751

Claims 1-7 are pending in this application.

### **DETAILED ACTION**

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirayama et al. (JP 10231234 A) in view of Atsushi et al. (EP 1 022 014 A1).

Hirayama (JP' 234) teaches a hair dyeing composition comprising 5-membered lactone skeleton of gamma-undecalactone carrying an alkali group having 7 carbon atoms as claimed in claims 1, 4 and 5, an acid dye, fragrance composition comprising fragrance substances of phenylacetaldehyde dimethyl acetal and 3,7-dimethyl-6-octen-1-ol as claimed in claim 2 and organic solvent of benzyl alcohol as claimed in claim 3 (see stic search report). The composition has a buffering ability and has a pH in the range of 2.5 to 4.5, which is falls within the claimed range as claimed in claim 1 (see English abstract).

The instant claims differ from the reference by reciting a composition having a buffer capacity not lower than 0.004 gram equivalent/L but lower than 0.2 gram equivalent/L. Also the reference is silent about the ClogP values of the fragrance components as claimed in claim 2. Further, the reference does not teach or disclose a method for dyeing hair as claimed in claim 7.

However, the primary reference of Hirayama teaches a dyeing composition comprising an alkali metallic salts of an acid so as to provide a pH buffering ability and the resultant composition is excellent in hair dyeing (see English abstract).

Atsushi (EP' 014) in analogous art of hair dyeing compositions, teaches a composition comprising an acid dye and alkylene carbonate wherein the composition exhibiting a pH of 2 to 6 and having a buffer capacity not lower than 0.007 gram equivalent/L but not lower than 0.2 gram equivalent/L which falls within the claimed range as claimed in claim 1 (see page 2, paragraph 0007 to paragraph 0012 and page 3, lines 1-2). Atsushi also teaches a method for dyeing hair wherein the method is similar to the method as claimed in claim 7 (see page 9, claim 5).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to optimize the buffer capacity of the composition of the primary reference to be within the range that taught by Atsushi with a reasonable expectation of success. Such modification would be obvious because the primary reference teaches a composition having a buffering ability and the secondary reference of Atsushi teaches clearly that the buffer capacity of the composition can impact the hair dyeing effect (see page 3, paragraph, 0013), and, thus, a person of the ordinary skill in the art would be motivated to optimize the buffering capacity of the composition so as to achieve a sufficient effect of dyeing, absent, unexpected results.

With respect to claim 2, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make a composition that comprises a fragrance substance having a ClogP value not greater than 1.5 and another fragrance substance having a ClogP value not smaller than 3.0 because the primary reference of Hirayama teaches a composition

Art Unit: 1751

comprising a fragrance component of phenylacetaldehyde dimethyl acetal that should have a ClogP value not greater than 1.5 and another fragrance component of 3,7-dimethyl-6-octen-1-ol that should have a ClogP value not smaller than 3.0 (see stic search report) because these fragrance substances are fall among the fragrance substances that provided by the applicant in the claimed invention (see specification page 10, line 12 and page 12, line 22), and, thus, a person of the ordinary skill in the art would expect such a composition to have similar properties to those claimed, absent, unexpected results.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirayama et al. (JP 10231234 A) in view of Atsushi et al. (EP 1 022 014 A1) and further in view of Yoshihara et al. (US 5,332,581).

The disclosures of Hirayama (JP' 234) and Atsushi (EP' 014) are summarized above. The references fail to teach or disclose dyeing compositions comprise acid orange 7 as claimed in claim 6.

However, Hirayama (JP' 234) teaches a dyeing composition comprising an acid dye component (see stic search report) and Atsushi (EP' 014) teaches a composition comprising a number of acid dyes (see page 2, paragraph 0007).

Yoshihara (US' 581) in other analogous art of hair dyeing compositions teaches a composition comprising acid orange 7 as an acid dye (see col. 3, line 59).

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the primary reference of Hirayama by incorporating the acid orange 7 as taught by Yoshihara to make such a composition. Such modification would be obvious because the primary reference suggests the

Art Unit: 1751

use of acid dyes in the composition and the secondary reference of Toshihara teaches clearly that the direct dyes (acid dyes) are used in the composition in order to elevate the elasticity of keratinous fibers and to change the color tone thereof (see col. 3, lines 14-16), and, thus, a person of the ordinary skill in the art would be motivated to incorporate the acid dyes as taught by the Toshihara in order to elevate the elasticity of keratinous fibers and to change the color tone thereof and would expect such a composition to have similar properties to those claimed, absent unexpected results.

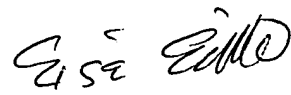
### *Conclusion*

The remaining references listed on form 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Eisa Elhilo  
Patent Examiner  
Art Unit 1751

September 17, 2003